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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,108	04/05/2001	Stephen K. Sundquist	P-9327.00	5008

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MEDTRONIC, INC.  
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EXAMINER

BOCKELMAN, MARK

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/827,108

Applicant(s)

SUNDQUIST ET AL.

Examiner

Mark W Bockelman

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 2-5, 11-13, 15-20, 24, 26, 28, 29 and 32-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-10, 14, 21-23, 25, 27, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

Art Unit: 3762

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of in Paper No. is acknowledged. The traversal is on ground(s) that are not provided in applicant's arguments. This is not found persuasive because no grounds are provided.

The requirement is still deemed proper and is therefore made FINAL.

The examiner agrees with applicant regarding claims 8-10 and 31 and will thus include these claims in the examination. However, the examiner disagrees with applicant's assessment as to which claims (as rewritten in the response of 5-01-03) read upon the elected species. Applicant states that claims 1, 3-10, 12, 14, 16-18, 21-23, 25, 27 and 30-31 read upon the elected species. However, the examiner notes that claims 3-5 and 12 depend from nonelected claim 2, claims 16-18 depend from non-elected claim 15. Therefore these claims do not read upon the elected species.

2. Claims 2-5, 11-13, 15-20, 24, 26, 28-29, 32-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5-01-03.

Art Unit: 3762

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1, 6-10, 14, 21-23, 25, 27, 30, 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonner et al USPN 5,902,331. Bonner et al USPN 5,902,331 show (e.g. fig 6.) an elongate guiding device 150 with a distal end 154 having an expandable balloon 152, a coupling member 70 and electrode assembly 12 with tines as a fixation means (or a helix -fig.7). The coupling member may be fastened to the guiding device to form a unified member. Similarly, the coupling member may also be fastened and unfastened to the electrode assembly and thus can slidably engage the electrode assembly. The coupling member has a rail 62 that when held properly keeps the electrode assembly from twisting (about the guide) during slidable engagement (i.e. upon retraction -column 15 lines 30-40). The examiner notes that the guiding catheter has a guidewire lumen extending therethrough (column 15 lines 62-67) which is capable of delivering

Art Unit: 3762

fluids (claims 8-10) and the balloon lumen in "included" in the coupling member since it passes through the coupling member lumen 68. The port at 154 is proximal ( i.e proximate) the balloon member.

5. Claims 1, 6-10, 14, 21-23, 25, 27, 30, 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Langberg et al USPN 6,527,769.

Langberg et al show on the front cover a guiding member 380, with a balloon 384 and a port 338 or 378 capable of delivering fluids. A coupling member 312 in the form of a rail slidably engages an electrode assembly 314 which has a fixation member 386 thereon.

6. Claims 1 rejected under 35 U.S.C. 102(b) as being anticipated by VandenEinde et al USPN 5,415,639 .

VandenEinde et al show a balloon catheter guide member with a coupler 314 (and or 302) for slidably engaging a guidewire. Applicant's recited intended use of the device with an electrode assembly fails to distinguish over VandenEinde since the VanfenEinde could potentially use an electrode assembly guidewire such as that described in Hofmann et al USPN 5,704,908.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Bockelman whose telephone number is (703) 308-2112. The examiner can normally be reached on Monday through Friday from 9:30 am to 6:00 pm.

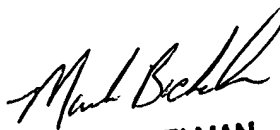
Art Unit: 3762

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes, can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3591.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

MWB

July 13, 2003

  
MARK BOCKELMAN  
PRIMARY EXAMINER